

REMARKS

CLAIMS

The amendment filed 8/16/2010 listed claims 1-46, 48-56, 58-63, as canceled, and listed claims 47, 57, and 64-71 as pending.

The 12/20/2010 Office Action (herein "OA") was in response to the amendment filed 8/16/2010. The OA summary page indicates that claims 47-71 are pending and examined and the OA first page of the detailed action indicates that claims 47, 57, and 61-71 are examined.

The applicant submits that claims 47, 57, and 64-71 are pending and have been examined.

OA numbered page 1 objects to claims numbered 65, 66, and requires claim renumbering. In response, the applicant has sequentially renumbered the claims.

OA numbered page 2 rejects claims 66, 69, 47, 57, under 35 USC 112, 1st paragraph reasoning that there was no support in the specification of "a particular network address"; a "network address" identifying the client computer." The examiner notes that "The claims only have support for identifying the client's computer where this is interpreted to be the client's email or social security number or online service address. Hence, the Applicant's claims are broader than the specification and the claims are only supported in this narrower interpretation of the 'client's computer' or of 'network address'." At OA page 3, the examiner also advised the applicant of guidance from the BPAI in a related case, stating:

And, importantly, the BPAI stated on 1211 212005, in regards to related case 091537,793, affirmed this similar 11 2 rejection as stated above. The BPAI on page 4 states:

"We will sustain the examiner's rejection of claims 47, 50, 52 and 53 for the reasons argued by the examiner. We agree with the examiner that each of the forms of identification discussed in appellants' specification identifies the user only and does not identify the user's computer. The user ID barcode, as disclosed, contains information which describes the user, not the user's computer. An online identification, such as an email address, also identifies the user and not the computer. A user can change computers and still receive email at the same address because the email address describes the user and not the computer. Thus, appellants' specification does not provide support for the recitation that the client computer is identified. Although most computer users may only use a single computer so that the identification of the user is tantamount to identifying the user's computer, the fact of the matter is that the types of identification described in appellants' specification only identify the user of the computer and do not uniquely identify the user's computer itself."

Hence, the "network address" will be interpreted as online service address or user online identification or email address of the user.

In response, the applicant has amended in view of the examiner's guidance, by removing recitation of a network address identifying the client computer, with suitable substitutions of a user identifier. The applicant notes that in related application the same examiner found that the language "transmitting said set of first user targeted coupon offers to said a client computer associated with said first user identification" was sufficient to overcome a corresponding 112, 1st paragraph rejection. See Application 10/871,381, attorney docket INVE0010-6, amendment after final dated 11/7/2010 and Advisory action dated 1/18/2011.

The examiner further notes at OA page 3 last paragraph that depends claims incorporated

the same limitations. In response, the applicant has reviewed the dependent claims for consistency.

OA page 8 indicates (indirectly) that all prior rejections have been withdrawn.

OA pages 4-8 reject all claims under 35 USC 103 basing the rejections upon the teachings of Von Kohorn and Saigh.

In response, the applicant submits that these rejections are barred by res judicata, law of the case doctrine, and improper under 37 CFR 41.54. This is due to the decision of the BPAI reversing the rejections of claims 47-63 under 35 USC 103 based upon Von Kohorn and Saigh, in the decision on appeal dated 8/21/2008 in this application. See Decision pages 34-37.

37 CFR 41.54 requires the examiner, in post appeal prosecution, to take actions "to carry into effect the decision." The general rule of law is that "when a court decides upon a rule of law, that decision should continue to govern the same issues in subsequent stages in the same case." Arizona v. California, 460 U.S. 605, 618, 75 L. Ed. 2d 318, 103 S. Ct. 1382 (1983). "The doctrine prevents the relitigation of settled issues in a case, thus protecting the settled expectations of parties, ensuring uniformity of decisions, and promoting judicial efficiency." Little Earth of the United Tribes, Inc. v. United States Dep't of Housing & Urban Dev., 807 F.2d 1433, 1441 (8th Cir. 1986) ("Little Earth"). See Morris v. American Nat'l Can Corp., 988 F.2d 50, 52 (8th Cir.1993) (quoting Arizona v. California, 460 U.S. 605, 618, 103 S.Ct. 1382, 75 L.Ed.2d 318 (1983)).

While ex parte administrative matters are not litigations between adverse parties, never the less, the concept of repose is embedded in PTO practice, for example requiring group director approval to make a new and different rejection after a BPAI decision reversing the examiner's rejection. In this specific case, law of the case is embedded in 37 CFR 41.54, which requires the post appeal examination to comport with the conclusions by the BPAI panel on issues raised and decided. An issue raised and decided in that appeal was whether Von Kohorn and Saigh provided within the meaning of 35 USC 103 a suggestion to electronically

Moreover, in this instance, the examiner relies upon the exact same evidence of prior art, Von Kohorn and Saigh, which the BPAI found to be insufficient to suggest electronic issuance and redemption of a coupon. That was in discussion of reversal of the rejection of claims 47-63 for obviousness under 35 USC 103 based upon Von Kohorn and Saigh. Specifically, the Decision first identifies the claims, the rejection, and the examiner's position, stating on page 34 that:

D. The Rejection of Claims 47-63 under 35 U.S.C. §103(a)

(i) Claims 47-63 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Von Kohorn and Saigh. (Ans. at 9).

More specifically, the Examiner has found that Von Kohorn describes all of the elements of claim 47, except that Von Kohorn does not describe that the electronic coupon is electronically redeemed by the central station. (Ans. at 10). The Examiner concluded that it would have been obvious to electronically redeem coupons for the added convenience. (Id.).

The Decision then concludes that Von Kohorn's teachings are inconsistent with electronic issuance and redemption of a coupon, that the rejection was improper and based solely upon impermissible hindsight, stating at pages 36-37 that:

In the Examiner's answer, page 26, the conclusion is reached "it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn electronic transfer of redemption information for

redemption to Von Kohorn's operator of a service that can redeem incentives. One would have been motivated to do this in order to allow Von Kohorn's users convenient incentive redemption."

We find that the reason stated for modifying Von Kohorn (to allow convenient coupon redemption) is, in this specific instance, insufficient. Von Kohorn is not motivated by convenient redemption for the user - rather, Von Kohorn is motivated by collection of data on the behavior of its users. Electronic issuance and redemption of the coupon of Von Kohorn would act to frustrate portions of Von Kohorn's invention, the dispensing and redemption of product-specific tokens, for example. Von Kohorn's principal thrust is to gather information electronically about the habits of consumers between the decision to purchase and the actual purchase.

Figure 28 is illustrative - an immediate paper reward, carrying advertising, is given to a user. Figures 29 and 30 specifically require a user to carry (924) a record of the transaction, a card, from the station (206C) where the coupon was generated to a redemption and authentication facility 906. This would enable a player to receive a prize for a winning wager. In other words, part of Von Kohorn's invention appears to be in the immediate sensation of a physical reward to a user.

The stated reason appears to us to be solely based upon impermissible hindsight. Accordingly, we reverse this rejection.

Note that claim 47 continues to recites the limitations that BPAI found not to be suggested by the combined teachings of Von Kohorn and Saigh, namely electronic issuance and redemption of a coupon, inter alia:

"a second server system connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon;"

Claim 57 contains an equivalent (for the purpose of defeating the Von Kohorn/Saigh rejection) recitation, inter alia:

"said client requesting information from said subsequent server; said subsequent server detecting said electronic coupon on said client; ... said subsequent server redeeming said electronic coupon"

New, since the Decision, claim 66, contains similar recitations in server centric format, inter alia:

"said server system being programmed to respond to receipt from a coupon redemption network address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed."

New since the Decision, claim 69, contains a similar recitation in server centric format, inter alia:

"said server system responding to receipt from a coupon redemption network address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed."

Accordingly, the rejection of all independent claims, and therefore of all claims, for obviousness, based upon Von Kohorn and Saigh, is barred by res judicata, law of the case, and improper under applicable PTO rules.

The applicant also notes the examiner's reliance on Saigh at 14:15-30 in the answer filed 3/7/2011 in Application 10/871,381, attorney docket INVE0010-6 for the proposition that Saigh discloses electronic redemption of coupons. (See Answer page 18 bottom paragraph.). The applicant respectfully disagrees with the examiner's conclusion. Saigh 14:15-30 does not disclose electronic redemption of coupons.

As explained in the appeal brief filed in 10/871,381, Saigh discloses that "The user may order products or information electronically via the network. Some of the promotional functions are: coupons on demand...". D2 does not contain "redemption" or "redeem". Thus, Saigh does not appear to disclose electronic redemption of coupons. Moreover, Saigh suggests that coupons are printed, and presented in paper format in the normal course of shopping. This is clear from the only other two references in Saigh to coupons. The first reference explains how the coupons come to reside on a system available to a user, stating that "Coupling to merchants' terminals promotional system provides local merchants and the local business direct access to update their promotions and coupons." The second and only other reference to "coupon" in Saigh is that "A printer 362 is provided to print coupons on demand, receipts and various reports for the users." Since this reference uses the term "coupons on demand" it logically applies to the Saigh 14:15-15:10 reference to coupons being downloaded by the user. Accordingly, what Saigh suggests is that a user download and then prints the coupons obtained by the coupons on demand function.

In any case, the BPAI panel decision in this application forecloses obviousness of a modification of Von Kohorn to avoid printing of coupons prior to redemption, for the reasons quoted from that Decision, above.

DATE: 3-18-2010

SIGNATURE: /RichardNeifeld#35,299/

PRINTED NAME: RICHARD NEIFELD, REG. NO. 35,2999

ATTORNEY OF RECORD

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